

### **REMARKS**

By this Reply, Applicant has amended claims 119, 121-130, 132, 134, 135, 138-151, 158, 166, 178, and 180. No new matter has been added by this Reply. Claims 119-182 remain pending in this application, of which claims 119 and 151 are independent.

In the Office Action mailed December 8, 2008 ("Office Action"), claims 119-143, 145-175, and 177-182 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2006/0185013 ("Oyama"), and claims 144 and 176 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Oyama.

#### **I. Claim Rejection Under 35 U.S.C. § 102(e)**

In the Office Action, claims 119-143, 145-175, and 177-182 were rejected under 35 U.S.C. § 102(e) as being anticipated by Oyama. Claims 119 and 151 are the only independent claims included in that claim rejection, and Applicant respectfully traverses the rejection of each of independent claims 119 and 151 under § 102(e) based on Oyama at least because the rejection statement has failed to establish that Oyama is eligible as prior art under 35 U.S.C. § 102(e).

Specifically, in order to qualify as prior art against Applicant's application under 35 U.S.C. § 102(e), Oyama must have been "filed in the United States before the invention by the applicant for patent." 35 U.S.C. § 102(e). "An international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application

designated the United States and was published under Article 21(2) of such treaty in the English language." Id. Oyama is a national phase of PCT International Application No. PCT/SE04/00945, which was filed on June 15, 2004, designated the United States, and was published in the English language. Thus, the 35 U.S.C. § 102(e) critical reference date of Oyama appears to be June 15, 2004.<sup>1</sup> Applicant's application is a national phase of PCT International Application No. PCT/EP2004/001105, filed February 6, 2004 (i.e., before the filing date of Oyama). Preliminary Amendment at 2 and Declaration of Inventorship, both filed August 4, 2006.

Because the filing date of Applicant's application is before Oyama's critical reference date under 35 U.S.C. § 102(e), the Examiner has not established that Oyama qualifies as prior art under 35 U.S.C. § 102(e). Accordingly, the 35 U.S.C. § 102(e) rejection of independent claims 119 and 151 based on Oyama should be withdrawn. Further, each of claims 120-143, 145-150, 152-175, and 177-182 depend, either directly or indirectly, from one of independent claims 119 and 151, and the rejection of those dependent claims over Oyama should be withdrawn as well.

Nevertheless, Applicant has amended independent claims 119 and 151 in the interest of advancing prosecution of this application. Specifically, Applicant has amended independent claims 119 and 151 to recite "negotiating the provision of said

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<sup>1</sup> Applicant notes that PCT International Application No. PCT/SE04/00945 claims the benefit of priority of two published U.S. patent applications, U.S. Provisional Application Nos. 60/479,156 (filed June 18, 2003) and 60/551,039 (filed March 9, 2004), only one of which predates Applicant's filing date. In order to establish the 35 U.S.C. § 102(e) critical reference date of a U.S. application publication (and certain international application publications) entitled to the benefit of the filing date of a provisional application under 35 U.S.C. § 119(e) as the filing date of the provisional application, "the subject matter used in the rejection must be disclosed in the earlier-filed application in compliance with 35 U.S.C. § 112, first paragraph." The Manual of Patent Examining Procedure (8th ed., rev. 7, July 2008) ("M.P.E.P.") § 706.02(f)(1)(I)(C)(1). Here, the rejection statement has not provided the necessary support that the subject matter used in the rejection was disclosed in either of the earlier-filed provisional applications so as to establish the critical reference date under § 102(e) as the filing date of either of the provisional applications.

mobile IP service via said authentication protocol over said pass-through transport, wherein negotiating the provision of said mobile IP service comprises authorizing said mobile node to use said mobile IP service and communicating to said mobile node a set of options for use of said mobile IP service." Oyama fails to disclose or render obvious at least this recited subject matter.

Oyama discloses a system and method for supporting hierarchical mobile IP services. Each of the system and method employ the Hierarchical Mobile IPv6 (HMIPv6) protocol to reduce the amount of signaling between a mobile node, its correspondent nodes, and its home agent by introducing a mobility anchor point (MAP) located in the visiting network. Oyama at paragraph [0004]. A MAP is a node in a network where the mobile node maintains a permanent address and a mapping between the permanent address and the local temporary address where the mobile node happens to be currently located. Id. at paragraph [0005]. According to Oyama, the system defines an extended EAP authentication protocol that carries HMIPv6-related information facilitating discovery of MAP, dynamic allocation of MAP, dynamic allocation of a Regional Care-of Address (i.e., the local temporary address of the MN stored associated with the MAP's subnet), distribution of security key(s) between MN and MAP, and/or possible piggyback of HMIPv6 mobility procedures. Id. at paragraphs [0005] and [0086]. HMIPv6-related information "may be normally regarded as part of the overall authorization procedure." Id. at paragraph [0021]. That is, HMIPv6-related information corresponds to the phase of the process that authorizes a mobile node to use a visited network. However, providing information for authorizing a mobile node to use a visited network, as described in Oyama, does not constitute "negotiating the

provision of said mobile IP service via said authentication protocol over said pass-through transport, wherein negotiating the provision of said mobile IP service comprises authorizing said mobile node to use said mobile IP service *and* communicating to said mobile node a set of options for use of said mobile IP service,” as recited in Applicant’s amended independent claims 119 and 151. (Emphasis added). In fact, Oyama appears to be silent with respect to communicating options for use of a mobile IP service to a mobile node, and does not disclose or render obvious such subject matter.

For at least the reasons noted above, Oyama fails to disclose or render obvious all of the subject matter recited in either of Applicant’s amended independent claims 119 or 151. Accordingly, the 35 U.S.C. § 102(e) rejection of amended independent claims 119 and 151 based on Oyama cannot be maintained and should be withdrawn. Further, each of claims 120-143, 145-150, 152-175, and 177-182 depend, either directly or indirectly, from one of amended independent claims 119 and 151 and should be allowable for at least the same reason that amended independent claims 119 and 151 are allowable. Therefore, Applicant respectfully requests reconsideration and withdrawal of the § 102(e) rejection with respect to claims 119-143, 145-175, and 177-182.

## **II. Claim Rejection Under 35 U.S.C. § 103(a)**

In the Office Action, claims 144 and 176 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Oyama. Claim 144 depends from independent claim 119 and claim 176 depends from independent claim 151. For the reasons outlined above, the Examiner has not established that Oyama qualifies as prior art over Applicant’s

application or that Oyama discloses or renders obvious all of the subject matter recited in amended independent claims 119 or 151. Therefore, the 35 U.S.C. § 103(a) rejection of dependent claims 144 and 176 should be withdrawn.

### III. Conclusion

In view of the foregoing remarks, Applicant respectfully requests reconsideration and reexamination of this application, withdrawal of the claim rejections, and the timely allowance of pending claims 119-182.

The Office Action contains characterizations and assertions regarding the claims and the cited art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant respectfully declines to automatically subscribe to any characterizations or assertions included in the Office Action.

If the Examiner believes that a conversation might expedite prosecution of this application, the Examiner is cordially invited to call Applicant's undersigned representative.

Please grant any extensions of time required to enter this Reply and charge any additional required fees to our Deposit Account 06-0916.

Respectfully submitted,

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